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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/622,001   | 09/22/2000  | Yasutaka Ishii       | 3273-0121P          | 5966             |
| 2292   | 7590        | 03/15/2004           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      | SOLOLA, TAOFIQ A    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1626                |                  |

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                                      |                                     |  |
|---|--------------------------------------|-------------------------------------|--|
| <p style="text-align: center;"><b>Office Action Summary</b></p> | <b>Application No.</b><br>09/622,001 | <b>Applicant(s)</b><br>ISHII ET AL. |  |
|   | <b>Examiner</b><br>Taofiq A. Solola  | <b>Art Unit</b><br>1626             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-3 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-3, 14-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____. |
|---|--|

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This Office Action supersedes all prior communications.

Claims 1-3, 14-21, are pending in this application.

Claims 4-13<sup>22</sup> are canceled.

### **Detail Action**

#### ***Election/Restrictions***

Claims 1-3, 14-21, are generic to a plurality of disclosed patentably distinct processes comprising the claims. The Markush set forth in the claims includes both independent and distinct inventions, and patentably distinct processes within each invention. The application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually. For example, the terms "organic compound and organic group" embrace the entire textbook of organic chemistry. The phraseologies "oxygen-atom containing compound having carbon-hydrogen bond at the adjacent position to an oxygen atom", "carbonyl-group-containing compound", a hydrocarbon group with a methane carbon" and "heteroatom-containing compounds" each embraces numerous compounds. Moreover, each of these inventions contains a plurality of patentably distinct processes, also far too numerous to list individually. For the reasons above, restriction is required under 35 U.S.C. 121, wherein a group is a set of patentably distinct inventions of a broad statutory category.

Applicant must elect a single and specific disclosed organic compound, organic group, oxygen-atom containing compound having carbon-hydrogen bond at the adjacent position to an oxygen atom", "carbonyl-group-containing compound", a hydrocarbon group with a methane carbon" and "heteroatom-containing compounds, even if the restriction may be traversed.

Applicant should be on notice that under US patent practice, the process of making a compound is not a utility, the product must have asserted utility or well established utility. The product also

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determines the class and subclass of the process. Such class and subclass must be searched to determine novelty. Therefore, the product must be recited in the claims.

In accordance with the decisions in *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984),

restriction of a Markush group is proper where the compounds within the group either

(1) do not share a common utility, or (2) do not share a substantial structural feature

disclosed as being essential to that utility. In addition, a Markush group may

encompass a plurality of independent and distinct inventions where two or more

members are so unrelated and diverse that a prior art reference anticipating the claim

with respect to one of the members would not render the other member(s) obvious

under 35 U.S.C. 103.

3. An election of a single process (or set of processes) is further required including an exact definition of each substitution on the base molecule (Formulae I, 1-20), wherein a single member at each substituent group or moiety is selected. For example, if a base molecule has a substituent group R1, wherein R1 is recited to be any one of H, OH, COOH, aryl, alkoxy, halogen, amino, etc., then applicant must select a single substituent of R1, for example OH or aryl, and each subsequent variable position. Applicant must elect one representative of "compound (A)", "compound (B)", R1, R2 and X in formula (I). If any of formulae 1 to 20, is elected, one single representative for each substituent must be elected as explained above.

In the instant case, upon election of a single process (or set of processes), the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected process (processes which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention will encompass all processes within the scope of the claims, which fall into the same class and subclass as the elected process (or set of processes), but may also include additional processes, which fall in related subclasses. Examination will then proceed on the elected process AND the entire scope of the invention encompassing the elected process as defined by common classification. A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits. Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of process. This will be set forth by reference to specific class(es) and subclass(es) examined.

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Should applicant traverse on the ground that the processes are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the processes to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C 103(a) of the other.

All processes falling outside the class(es) and subclass(es) of the selected processes and any other subclass encompassed by the election above will be directed to nonelected subject matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R.

1.142(b). Applicant may reserve the right to file divisional applications on the remaining subject matter. The provisions of 35 U.S.C. 121 apply with regard to double patenting covering divisional applications.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Rick Gallager on 1/7/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventors must be amended in compliance with 37C.F.R. 1.48(b) if one of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37CFR 1.17(i).

If desired upon election of a single process, applicants can review the claims and disclosure to determine the scope of the invention and can **set forth** a group of processes, which are so similar within the same inventive concept and reduction to practice. Markush claims must be provided with support in the disclosure for each member of the Markush group. See MPEP 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the base molecule to be consistent with the written description.

***Rationale Establishing Patentable Distinctiveness Within Each Group***

The invention set forth above is directed to or involves making of compounds which are recognized in the art as being distinct from one another because of their diverse chemical structure, their different chemical properties, modes of action, different effects and reactive conditions (MPEP 806.04, MPEP 808.01). Additionally, the level of skill in the art is not such that one invention would be obvious over either of the other inventions, i.e. they are patentable over each other. Chemical structures, which are similar are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly. The presumption even for similar chemical structures though is not irrebuttable, but may be overcome by scientific reasoning or evidence showing that the structure of the prior art would not have been expected to function as the structure of the claimed invention. Note that in accordance with the holdings of Application of Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and In re Laly, 223 USPQ 1257 (Fed. Cir. 1984), chemical structures are patentably distinct where the structures are either not structurally similar, or the prior art fails to suggest a function of a claimed compound would have been expected from a similar structure.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (703) 308-4690.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (703) 308-4532. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
TAOFIQ SOLOLA  
PRIMARY EXAMINER  
1626

March, 2004